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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,028	08/16/2001	Takami Mackawa	212833US0PCT	1278
22850	7590	03/23/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SAKELARIS, SALLY A	
			ART UNIT	PAPER NUMBER

1634

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/926,028

Applicant(s)

MAEKAWA ET AL.

Examiner

Sally A Sakelararis

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: The proposed amendment extensively modifies the claims and as a result will not be entered. The recitation of "of one strand of the linear plasmid vector" and the subsequent amendments to part (a) of claim 1 raise issues under 112 2nd paragraph definiteness and include new limitations that require a new and revised search of the prior art. In addition, the recitation of "in order from the poly(T) sequence" raises issues under 112 1st paragraph written description new matter.

Continuation of 5. does NOT place the application in condition for allowance because: the applicant's traversal on the grounds that the "examiner has not fully understood the present invention" and as a result has "misapplied the inoperativeness standard" and "overlooked the important aspect provided by the claims, the figures and the examples". First, while applicant's explanations of the invention are acknowledged, it should be reiterated that limitations of the specification should not be read into the claims and as such the examiner's rejections in the previous final office action are maintained. In regard to applicant's comments concerning the enablement rejection, applicant is pointed to page 11's scope of invention section of the final office action sent on 9/26/2003. The claim's broad language lends itself to various permutations in which the invention is inoperable by the recitation for example of "a second restriction enzyme near the 5' end of the strand" does not require that the site be at a distinct distance away from the poly(T) sequence or a distinct distance from the 5' end, as a result "near can and was interpreted to mean anywhere from at the 5' end to one nucleotide upstream the poly(T) sequence. While applicants table in their response after final is acknowledged, applicant should note that limitations of applicant's remarks and the specification will not be read into the claims. Please reference the examiner's maintained response to applicant's reassertion of their arguments from June 25, 2003. Until the claims are found to be definite, the art teaches the presently written limitations of claims 1-3. In response to applicant's arguments concerning the finality of the last office action, applicant should note that the finality was necessitated by applicants amendments to the claims which necessitated new rejections. In summary, as stated in the Final action, dated 9/26/2003, the examiner finds the remaining traversals not convincing as it is maintained that the present invention is not claimed to encompass the argued limitations. Furthermore, the remaining rejections are also maintained for reasons of record in view of the non-entry of after final amendment.


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (571)272-0748. The examiner can normally be reached on Monday-Thursday from 7:30AM-5:00PM and Friday from 1:00PM-5:00PM.

If attempts to reach the examiner are unsuccessful, the primary examiner in charge of the prosecution of this case, Jeffrey Fredman, can be reached at (571)272-0742. If attempts to reach the examiners are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782. The official fax number is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to Chiantae Dessau whose telephone number is (571)272-0518.

Sally Sakelaris

3/16/04


GARY BENZION, PH.D.
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3/22/04